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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,634	08/22/2003	Jack Hou		8020

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Great Falls, VA 22066

EXAMINER

WRIGHT, ANDREW D

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/645,634

Applicant(s)

HOU, JACK

Examiner

Andrew Wright

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 11-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/22/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 18 and 19 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent should refer to other claims in the alternative only. See MPEP § 608.01(n). In this case, claim 18 depends from both claims 3 and 16. And claim 19 from claims 18 and 13. Accordingly, the claims have not been further treated on the merits.
2. Claim 1 is objected to. In line 1, "mainly" should be deleted. In line 8, "the bottom opening" should be amended to be consistent with the previous recitation of "a bottom portion opening". Consistent terminology should be used throughout the claims. In line 12, "Wherein" should be changed to "wherein". The capitalization is improper. Appropriate correction is required.
3. Claim 3 is objected to. Claim 3 recites "for installing a decoration or a mechanism described in claim 2." Claim 2, from which claim 3 depends, recites "a mechanism for... at least one decoration". In claim 3, if the recitation is referring to the same decoration as recited in claim 2, then the phrase "the decoration" should be used. In claim 3, "a mechanism described in claim 2" should be replaced with "the mechanism". It is improper to positively recite it a second time. And there is no need for the language "described in claim 2".
4. It is noted that claim 3, along with many other claims, has intended use recitations: "for supporting the first magnet", "for supporting the second magnet", for installing a decoration or a mechanism", etc. A recitation of the intended use of the

claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). It is suggested that the recitations be written as positive recitations of structure: "supports the first magnet", "supports the second magnet", "on which the decoration or mechanism is installed", etc.

5. Claim 4 is objected to. The word "stopped" should be "stopper".

6. Claim 7 is objected to. Claim 7 recites "the contents". This recitation lacks antecedent basis in the claims. From the specification it is understood that the housing is filled with liquid contents. This will be assumed as a structural recitation of claim 7. The claims must have a positive recitation.

7. Claim 10 is objected to. Claim 10 recites "at least one decoration". If the recitation of claim 2 is a positive recitation of at least one decoration, then it is improper to positively recite it again in later claims. Claims 13-18 have similar language. It will be assume that there is only one decoration and that all the recitations refer to the same decoration.

8. Claim 11 is objected to. In the phrase "causes the up and down", the word "the" should be deleted.

9. Claim 13 is objected to. In the phrase "the rotation", the word "the" should be deleted.

10. Claims 15-18 have parenthetical expressions. The claims should be written without parentheses.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Claim 18 recites "and a longitudinal slot (similar to that described in claim 16)".

Aside from the objection noted above, this renders the claim indefinite. Use of the phrase "similar to" is unclear. Claim 19 depends from claim 18.

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

15. Claims 1-3 and 5-8 are rejected under 35 U.S.C. 102(a) as being anticipated by Huang (US 6,508,022). Huang shows a display device. The floor with feet, shown in figure 1 below driving mechanism (40), is the support base. One foot is the support extending therefrom. Base (20) is the decorative base. Globe (30) is the transparent housing. It has an opening at the bottom. It has a section that is within the decorative base. Stopper (34) is the stopper. It covers the bottom opening and does not have a

hole on its center portion. First magnet (58) is above the stopper. Second magnet (46) is below the stopper. Power source (40) is capable of rotating the second magnet.

(Note that "for rotating the second magnet" is an intended use recitation").

16. Regarding claim 5, the power source (40) is a spring motor (column 2, line 39).

17. Regarding claim 7, an embodiment is shown in figure 6 where a vane (59) is installed with the first magnet.

18. Regarding claim 2, gear wheel (42), coupler (43), shaft (45), and bar (44) constitute a mechanism. The mechanism is capable of transmitting power from the source to the decoration.

19. Regarding claim 3, the apparatus comprises connecting member (51), first rotary member (52), second rotary member (44), and lid (55).

20. Regarding claim 6, the embodiment in figure 6 shows a gear (47) and coupler (43).

21. Regarding claim 8, lid (55) is a ring and therefore has an opening.

***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (US 6,508,022) in view of Yuen (US 6,568,107). Huang shows all of the features of claims 1-3. Huang shows a second recess. Huang does not show a first recess.

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Yuen shows fluid filled globe display similar to that of Huang. Yuen shows a water-tight stopper and magnets on either side of the stopper, similar to Huang. Yuen shows one embodiment where the stopper (76, 82) has edges that extend upwardly into the globe. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Huang with such that the edges of the stopper extend upwardly into the globe. The motivation would be to direct the flow of fluid within the globe and to enhance the aesthetic value of the display. The upwardly extending side edges form a first recess.

24. Claims 1-3, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (US 6,508,022) in view of Lee (US 6,523,287). Huang shows all of the features of claims 1-3. Huang does not show a first gear, second gear, third gear, and rotary cover. Lee shows a fluid filled globe display similar to that of Huang. Lee shows a driving magnet below the stopper and a driven magnet above the stopper. Lee shows first, second, and third gears, and a rotary cover (figures 3-6) associated with the driven magnet above the stopper. The gears and rotary cover provide a specific motion for the components inside the globe, as is well known in the art. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Huang by adding three gears and a cover as taught by Lee. The motivation would be to provide a certain type of motion to the components inside the globe.

***Allowable Subject Matter***

25. Claims 11-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

26. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

**Certificate of Mailing**

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\_\_\_\_\_

Signature: \_\_\_\_\_

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

27. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

28. If applicant chooses to continue prosecution alone, a proper response to an Office Action should include:

- (a) Acknowledgement of objections to the drawing and/or specification by specific instructions to correct these defects, and
- (b) Instruction to cancel or amend the rejected claims, or to substitute or add claims to be considered by this Office (all amendments must comply with 37 CFR 1.121 (available at the [www.uspto.gov](http://www.uspto.gov) website)), or
- (c) An argument under the heading "Remarks" in which Applicant points out wherein he may disagree with Examiner's contentions and wherein he also discusses the references applied against his claims, explaining how his claims avoid these references or distinguish from them in a patentable sense.

An example of a proper response to an Office Action can be found at:

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/formatrevamdtprac.pdf>

29. Any inquiry concerning this communication should be directed to examiner Andrew D. Wright at telephone number (703) 308-6841. The examiner can normally be reached Monday-Friday from 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano, can be reached at (703) 308-0230. The fax number for official communications is 703-872-9306. The fax number directly to the examiner for unofficial communications is 703-746-3548.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew D. Wright  
Patent Examiner  
Art Unit 3617

*Ar 9-16-04*  
**ANDREW D. WRIGHT**  
**PRIMARY EXAMINER**